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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,023	04/06/1999	DALE W. MALIK	BS100/176677	5759

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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

NGUYEN, DUC MINH

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 03/15/2004

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/287,023

Applicant(s)

MALIK

Examiner

Duc Nguyen

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-36 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-36 and 38-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-17, 26-29, 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (6,424,706) in view of Benyacar et al (5,003,584).

Consider claims 10, 12. Katz teaches a method for using a communication to conduct a transaction with respect to a telecommunications account, comprising receiving the communication at the service switching point (end office 151, fig. 3A), the communication being associated with a CLID (caller ID; col. 17, ln. 36-58); causing the SSP to route the communication to the intelligent network element (prepaid platform 170, fig. 3A); causing the intelligent network element to obtain an account number (account associated with subscriber 210; col. 13, ln. 45 to col. 14, ln. 6) and a transaction amount from the communication (col. 7, ln. 1-19), the account number corresponding to an account with respect to which transaction is to be conducted in the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A), the account associated with a recipient (account associated with subscriber and/or recipient 210; col. 13, ln. 45 to col. 14, ln. 6) other than a subscriber associated with a calling line number account associated with the calling line number (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an

Art Unit: 2643

amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); performing the transaction based on the account number, the transaction amount, and the calling line number (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6; col. 17, ln. 36 to col. 18, ln. 21); and using the account number and the transaction amount to execute the transaction with respect to the account corresponding to the account number (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6). Katz does not explicitly teach the billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

Consider claim 11. The special access code is met by the 1-800 number (toll free telephone call; Katz, col. 14, ln. 52-55).

Consider claims 13, 28. Katz further teaches charging a fee for the transaction (transaction fees; col. 16, ln. 3-6).

Art Unit: 2643

Consider claim 14. Katz, Col. 14, ln. 55-61 reads on the limitations of claim 14.

Consider claims 15, 17. Katz further teaches causing the prepaid platform (170) to carry out a validation whose result comprises a determination that the calling line number is authorized with respect to conduct of the transaction (col. 17, ln. 36-48).

Consider claim 16. Katz, Col. 17, ln. 49-58 read on the limitations of claim 16.

Consider claims 26-27, 29. Katz teaches a method for execution of a transaction in the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A) between the calling line number account (prepaid account associated with subscriber/caller 100; col. 13, ln. 24-31) and one of the other accounts (account associated with subscriber 210; col. 13, ln. 45 to col. 14, ln. 6) to which the billing system has access, comprising providing a message includes an indication for the execution of the transaction (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6), causing the billing system to make a recognition of the indication in the message (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); and in response to the indication in the message, inherently causing the billing system to execute the transaction between the calling line number account associated with a subscriber and the one of the other accounts associated with a recipient other than the subscriber (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6). Katz does not explicitly teach

Art Unit: 2643

a billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

Consider claim 35. Katz teaches a method for executing a transaction, comprising receiving a communication associated with a calling line number (col. 14, ln. 40 to col. 15, ln. 12); obtaining a transaction amount from the communication (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); inherently coding the transaction amount and the calling line number into a message (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); inherently posting the message (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); inherently obtaining the message, and decoding the transaction amount and the calling line number from the billing message (caller/subscriber 100 uses the prepaid platform 170 to transfer

Art Unit: 2643

unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); and crediting or debiting an account by the transaction amount, the account associated with a recipient other than a subscriber associated with the calling line number (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6). Katz does not explicitly teach the billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

Consider claims 34, 36. Katz teaches a system for allowing a user to initiate a transaction and have the transaction conducted, comprising a service switching point (end office 151) for receiving a communication from a user, and for obtaining and acting on instructions regarding the communication (fig. 3, col. 14, ln. 40 to col. 16, ln. 31); a service control point (prepaid platform 170) for providing the instructions regarding the communication to the SSP, the instructions instructing the SSP to retrieve transaction information and to forward the transaction information to the SCP, for including the transaction information in a message by assigning the

Art Unit: 2643

transaction information to at least a field of the message, and for posting the message for retrieval by a billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A); and the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A) for inherently retrieving the message (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6), for inherently recognizing the transaction information in the message, and based on the recognition, for inherently conducting the transaction based on the transaction information (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); and crediting or debiting an account by the transaction amount, the account associated with a recipient other than the user (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6). Katz does not explicitly teach the billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by

Art Unit: 2643

Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

3. Claims 1-7, 18-25, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (6,424,706) in view of Benyacar et al (5,003,584) and Lesley (6,333,976).

Consider claims 1-3. Katz teaches a system for allowing a user to initiate a transaction and have the transaction conducted, comprising a service switching point (end office 151) for receiving a communication from a user, and for obtaining and acting on instructions regarding the communication (fig. 3, col. 14, ln. 40 to col. 16, ln. 31); a service control point (prepaid platform 170) for providing the instructions regarding the communication to the SSP, the instructions instructing the SSP to retrieve transaction information and to forward the transaction information to the SCP, for including the transaction information in a message by assigning the transaction information to at least a field of the message, and for posting the message for retrieval by a billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A); and the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A) for inherently retrieving the message (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6), for inherently recognizing the transaction information in the message, and based on the recognition, for inherently conducting the transaction based on the transaction information (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14,

Art Unit: 2643

ln. 6); and crediting or debiting an account by the transaction amount, the account associated with a recipient other than the user (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6). Katz does not explicitly teach the billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

Katz in view of Benyacar does not clearly teach the recipient's account is a telecommunications account.

Lesley teaches a method and system for transferring monetary from a subscriber's telephone account to a subscriber's prepaid telecommunication account (col. 6, ln. 59 to col. 7, ln. 28; col. 8, ln. 50 to col. 9, ln. 9). Lesley further teaches an SCP (20) which functions as an prepaid platform (see fig. 1; col. 6, ln. 21-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Katz in view of

Art Unit: 2643

Benyacar, so that subscribers can easily add or transfer money from one telecommunication account to other telecommunication account by accessing the prepaid network.

Consider claim 7. Katz, Col. 14, ln. 55-61 reads on the limitations of claim 7.

Consider claims 4-5. Katz further teaches causing the prepaid platform (170) to carry out a validation whose result comprises a determination that the calling line number is authorized with respect to conduct of the transaction (col. 17, ln. 36-48).

Consider claim 6. Katz, Col. 17, ln. 49-58 read on the limitations of claim 6.

Consider claims 18-23. Katz teaches a method to conduct a transaction with respect to a telecommunications account (pre-paid account; col. 13, ln. 24-31) in the system, comprising obtaining a billing message generated as a result of a telecommunications service performed with respect to a calling line number (col. 14, ln. 40 to col. 16, ln. 31); in response to obtaining of the billing message, the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A) inherently makes a determination that the billing message includes an indication that a transaction is to be conducted with respect to a an account in the system, the account associated with a recipient other than the subscriber associated with a calling line number account associated with the calling line number (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14, ln. 6); and in response to the determination, the billing system (prepaid billing system in associated with unit minute system 340 and financial network shown in fig. 3A) inherently conducts the transaction with respect to the account (caller/subscriber 100 uses the prepaid platform 170 to transfer unit minute which represents an amount of monetary to subscriber/ recipient 210; fig. 2A; col. 13, ln. 45 to col. 14,

Art Unit: 2643

ln. 6). Katz does not explicitly teach the billing message includes a the telecommunication account number, the transaction amount and the calling line number.

Benyacar teaches creating a billing message that includes a telecommunication account number, a transaction amount, and the calling line number (fig. 3-4; col. 7, ln. 16 to col. 10, ln. 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Katz and Benyacar (e.g., incorporating the telecommunication account, the transaction amount and the calling line number as taught by Katz into the billing message as taught by Benyacar) in order to provide a convenience and highly secure fund transfer system.

Katz in view of Benyacar does not clearly teach the recipient's account is a telecommunications account.

Lesley teaches a method and system for transferring monetary from a subscriber's telephone account to a subscriber's prepaid telecommunication account (col. 6, ln. 59 to col. 7, ln. 28; col. 8, ln. 50 to col. 9, ln. 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Katz in view of Benyacar, so that subscribers can easily add or transfer money from one telecommunication account to other telecommunication account by accessing the prepaid network.

Consider claims 24-25, 30-31. Lesley combines the invoice relates to the transaction conducted with respect to the telecommunications account (i.e., prepay account) and the invoice for the different telecommunications account (subscriber's home telephone account) (col. 9, ln.

Art Unit: 2643

5-9). Furthermore, the mere fact that a given structure is integral does not preclude its consisting of various elements, Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969). There is also a requirement that the unification or integration involve more than just mere mechanical skill. In re Murray, 19 C.C.P.A. (Patents) 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 C.C.P.A. (patents) 832, 186 F.2d 735, 88 USPQ 367. It appears that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the telecommunication test system, than on any inventive concept.

Consider claims 32-33. (Lesley's col. 9, ln. 29-33) reads on the limitations of claims 32-33.

Consider claims 38-40, 44, 48-50. Benyacar, Figs. 3-4; col. 7, ln. 16 to col. 10, ln. 50 read on the limitations of claims 38-40, 44, 48-50.

Consider claims 41-43, 45-47. Benyacar, col. 1, ln. 10-51 reads on the limitations of claims 41-43, 45-47.

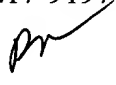
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is 703-308-7527. The examiner can normally be reached on 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Duc Nguyen
Primary Examiner
Art Unit 2643

3/5/04